REMARKS/ARGUMENTS

This Amendment is in response to the Office Action of July 20, 2009, in which the Examiner rejected claims 19, 25-27 and 30-36 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2007/0124795 ("**McKissick**") in view of U.S. Patent Application Publication No. 2002/0124247 ("**Houghton**").

By the present Amendment, claim 30 has been amended to further clarify the functioning of the communication network recited therein. Support for amended elements in claim 30 can be found in Figs. 2, 4-6, 11 and 12, and in the Specification, for example, at paragraphs 0036, and 0058-0060. No new matter has been added.

Claim 30 and its dependent claims are allowable:

Independent claim 30 recites a communications network including, *inter alia*, an IM server operated by an IM service provider for receiving, displaying and sending IM messages among a plurality of interconnected IM users, the IM server also managing personal profile data entered by the users, a survey database connected to the IM server for receiving and storing data relating to the displayed IM messages, and a survey server separate from the IM server for receiving from the survey database data relating to IM messages displayed at the user interface, for aggregating IM content, including program IDs and keywords present in the displayed IM messages, and personal profile data of the users associated with the displayed IM messages, and for generating reports using the aggregated IM content and the personal profile data so that video programming activity by multiple users may be tracked at the survey server.

The survey server recited in claim 30 allows providers to track users' video programming activity using not only the users' profile data, but also using the users' IM content, including program IDs and keyword present in the displayed IM messages. As the survey manager recited in claim 30 has access to data gleaned from the IM messages, it is able to use such IM content to generate better reports for analyzing the users' video programming activities. For example, if a user viewing a particular TV program makes a comment about such TV program in an IM, such comment can be stored in the survey database and can be used by the

survey server in generating a report about that particular TV program. Such capability of the

survey server allows generating reports where key words present in the IM messages can be

linked to the programs. Thus, for example, if a the word "great" is selected to be a keyword,

every time an IM content includes the word "great," it can be linked with the program being

watched by the user generating that particular IM content. Moreover, because the data regarding

such favorable or unfavorable IM activity is being collected in real-time, the reports generated by

the survey server can link such data to particular parts of TV programs as well.

None of the prior art cited in the Office Action discloses a survey server for

receiving from a survey database data relating to IM messages displayed at the user interface, for

aggregating IM content, including program IDs and keywords present in the displayed IM

messages, and personal profile data of the users associated with the displayed IM messages, and

for generating reports using the aggregated IM content and the personal profile data so that video

programming activity by multiple users may be tracked at the survey server, in a manner recited

in claim 30.

Houghton discloses an interactive polling system for television viewers that

sends a set of polling requests to set top systems used by one or more interactive television

viewers, receives responses to the set of polling requests, and prepares new polling requests

based on the initial responses to the polling requests. However, **Houghton** does not disclose a

survey server for receiving from a survey database data relating to IM messages displayed at the

user interface, for aggregating IM content, and for generating reports using the aggregated IM

content and personal profile data of the users associated with the displayed IM messages.

The Office Action argues that Fig. 6 and pg. 8, par. 80-81 of **Houghton** discloses

"a survey server separate from the IM server for receiving from the survey database data relating

to IM messages displayed at a user interface, for aggregating IM content, including program IDs

and keywords present in the displayed IM messages, … and for generating reports …." See

Office Action, pg. 4, ll. 17-21. However, Fig. 6 merely discloses a subscriber profile server 6912

and associated database 6914 for storing "large amounts of subscriber profile data" such as the

subscriber's buddy list, alert preferences, etc. See **Houghton**, paragraph 0080. There is no

mention in Houghton about aggregating any IM content, let alone generating any reports based

Appl. No. 10/840,026
Amdt. dated October 20, 2009
Reply to Office Action of July 20, 2009

PATENT

on such aggregated IM content and the personal profile data. Simply put, **Houghton** does not disclose storing IM content (IM messages and program IDs), and therefore, it cannot teach or suggest aggregating such IM content and preparing reports based on such IM content and subscriber profile data.

In order to establish a *prima facie* case of obviousness, all claimed limitations must first be taught or suggested by the prior art. *See, e.g.*, *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). The Office Action must then provide an explicit analysis supporting the rejection. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). While the Office Action can use one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, each rationale still requires the Office Action to demonstrate that all the claim elements are shown in the prior art. *See* MPEP §2143. As will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation.

Because neither **Houghton** or **McKissick**, taken individually or in combination, teaches or suggests a survey server for receiving from a survey database data relating to IM messages displayed at the user interface, for aggregating IM content, including program IDs and keywords present in the displayed IM messages, and personal profile data of the users associated with the displayed IM messages, and for generating reports using the aggregated IM content and the personal profile data so that video programming activity by multiple users may be tracked at the survey server, in a manner recited in claim 30, claim 30 is patentable over the cited references.

Applicant again submits that **Houghton** and **McKissick**, even if assumed (for purpose of argument) that they disclose all of the features of the claim, are not properly combined for teaching the subject matter of claim 30. As pointed out in the Specification (par. 0058-0060), the present invention permits advantageous use of data generated during an IM session to collect data on how viewers are reacting to a television program, based on the IM messages being posted (and the program identifiers, keywords present in the IM messages, and

Appl. No. 10/840,026
Amdt. dated October 20, 2009
Reply to Office Action of July 20, 2009

PATENT

the profile information associated with the IM messages). In contrast, **Houghton** involves the transmission of an electronic ballot to interactive television viewers, and compiling the responses (votes) in order to determine the relative preferences of users (see paragraphs 0089, 0104, and 0114). **Houghton** does not suggest taking advantage of data already being generated (i.e., data from the generation of IM messages) in conjunction with a broadcast television in order to report on video programming activity. If anything, **Houghton** teaches away from the present invention by teaching the loading and use of separate and dedicated electronic ballots in order to obtain data (votes) directly from viewers, rather than advantageously deriving that information from already generated IM messages.

In connection with **Houghton** teaching away, the Examiner states in the last Office Action (page 2, line 19 - page 3, line 2) that **Houghton** does not teach away since in **Houghton** polling information "can also be extrapolated from the stored information in the profile servers as requested by the host server, based on the historical information stored therein."

Applicant again points out that in **Houghton**, tracking of viewer programming activity is accomplished by polling the viewers for data, not by aggregating IM content stored in the profile server 6912. In **Houghton**, the profile server and its associated database 6914 only store subscriber profile information (subscriber buddy lists, alert preferences, designated stocks, identified interests, and geographical information), and not IM content, including "program IDs and keywords present in the displayed IM messages" as recited in claim 1. Thus, **Houghton** teaches away from the present invention by requiring the use of separate polling requests to aggregate programming activity data from users, rather than teaching the advantageous use data already generated during an IM session.

Finally, in combining references, the Office Action is required to state a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2143. Further as stated in *KSR* at 1727, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated underpinnings to support the legal conclusion of obviousness." The basis for combining **Houghton** with **McKissick** stated by the Office Action (page 4, l. 22 – page 5, l. 3) is the motivation to combine the references "due to

the fact that the references deal with distributing instant message in a network and storing user profiles." Applicant respectfully submits that the Office Action has not met the requirements for making an obviousness rejection, either under the MPEP or as required in *KSR*. Among other things, there is no stated basis for why it would be obvious to use IM messages content in either **Houghton** or **McKissick** to generate reports that track video programming activity, as in the present invention.

Thus, at least for the reasons cited above, claim 30 is believed allowable over **Houghton** and **McKissick**. Dependent claims 19, 25-27, and 31-36 each recite limitations in addition to those recited in independent claim 30 are believed allowable for at least the same reasons as stated above.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Stephen F. Jewett/
Stephen F. Jewett
Reg. No. 27,565

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
62269721 v1